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OFFICE OF PETITIONS

In re Application of
Rubinstein et al.
Application No. 10/694,338
Filed: October 27, 2003
Attorney Docket No. TH1786(US)

ON PETITION

This is a decision on the petition under 37 CFR §§ 1.78(a)(6), filed December 13, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 119(e) for the benefit of prior-filed provisional Application No. 60/421,752, filed October 28, 2002, as set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR §§ 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR §§ 1.78(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the above-noted, prior-filed application.

The instant pending nonprovisional application was filed on October 27, 2003, and was pending at the time of filing of the instant petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR §§ 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§ 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §§ 1.78(a)(6). In the instant case, the Office noted the claim for priority of the above-noted, prior-filed application in the transmittal letter and declaration filed with the application, as shown by its inclusion on the filing receipt.

¹ Note MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

In view of the above, the \$1500.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

The instant petition also referenced Application No. 09/850,943, but failed to address its relevance in the amendment. Petitioner should clarify whether or not benefit to Application No. 09/850,943 is also requested. At this time, the instant application only claims benefit to the provisional application, as listed in the amendment concurrently submitted with the instant petition.

Any questions concerning this decision on petition may be directed to Paralegal Liana Chase at (571) 272-3206. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 1625 for appropriate action on the amendment filed December 13, 2004, including consideration of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for benefit of the above-noted, prior-filed provisional application.



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